

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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PFIZER INC.,

:

Plaintiff, : No. 08-cv-8065 (WHP)

v.

:

ARYE SACHS and JETANGEL.COM,

:

Defendants.

:

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**PLAINTIFF PFIZER INC.'S LOCAL RULE 56.1
STATEMENT OF UNDISPUTED FACTS IN SUPPORT
OF SUMMARY JUDGMENT AND AN AWARD OF ATTORNEYS' FEES**

Pursuant to Local Civil Rule 56.1, plaintiff Pfizer Inc. ("Pfizer") submits this statement in support for its motion for summary judgment on its claims that defendants JetAngel.com and Arye Sachs (together, "defendants") have engaged in trademark infringement and dilution of Pfizer's well-known VIAGRA® and VIVA VIAGRA trademarks (together "Viagra Marks"), have engaged in acts of false designation of origin, false endorsement, false association and unfair competition in violation of federal and state law, and that this is an exceptional case pursuant to 15 U.S.C. § 1117.

This statement is based upon, *inter alia*, the Declaration of Ruth Dovdavany dated October 31, 2008 ("Dovdavany Decl.") and exhibits thereto and the Declaration of Tiffany Trunko dated November 7, 2008 ("Trunko Decl.") and exhibits thereto. Both of the foregoing declarations are substantially identical to those submitted in support of Pfizer's application for a temporary restraining order and preliminary injunction in this matter, with the addition of certain facts in Dovdavany Decl. ¶¶8, 18, 23, and Trunko Decl. ¶16.

Pfizer and Its Famous Viagra Marks.

1. Pfizer is a research-based, global pharmaceutical company that, *inter alia*, develops, manufactures, and sells prescription pharmaceutical products. Dovdavany Decl. ¶4.
2. One of Pfizer's best known and most successful products is its VIAGRA® (sildenafil citrate) product, a prescription pharmaceutical for the treatment of erectile dysfunction. *Id.*
3. Pfizer spent hundreds of millions of dollars and extensive resources on research and development of its VIAGRA® brand therapy, which was the first oral medication by the United States Food and Drug Administration ("FDA") for treating erectile dysfunction. The launch in 1998 of Pfizer's VIAGRA® product, the first FDA-approved oral treatment for erectile dysfunction, represented a major medical breakthrough. *Id.*
4. Pfizer owns a valid, subsisting and existing U.S. Trademark Registration, No. 2,162,548, for the trademark VIAGRA® for a "compound for treating erectile dysfunction." *Id.* ¶5; Trunko Decl. ¶3 & Ex. A.
5. The VIAGRA® mark is a coined or fanciful term that has no meaning apart from its meaning as an indicator of Pfizer's products and services, and is inherently distinctive to both the trade and the consuming public. Dovdavany Decl. ¶5.
6. Since introducing its VIAGRA® product in 1998, Pfizer has spent many millions of dollars to promote its VIAGRA® product and trademark in a wide range of media, including national broadcast and cable television, radio, nationally and internationally circulated newspapers and magazines. The VIAGRA® product is also promoted at medical conventions in the United States and around the world. *Id.* ¶7.

7. Even prior to FDA approval of the VIAGRA® product, the VIAGRA® product and mark received enormous media attention including a cover story in *Newsweek* magazine and discussion on such popular television programs as “20/20” and “Today.” *Id.* ¶6 & Ex. A.

8. The approval of the VIAGRA® product was highly publicized, including feature articles in publications such as *USA Today* and *The New York Times*, and there continues to be extensive media coverage of the VIAGRA® product and trademark. *Id.*

9. Among other media, Pfizer has promoted its VIAGRA® product extensively in outdoor or “out-of-home” advertising, such as advertising at sporting events. For example, from approximately 2002 to 2006, Pfizer’s VIAGRA® brand was an official sponsor of Major League Baseball, and advertisements featuring the VIAGRA® mark appeared on billboards at Major League Baseball stadiums throughout the United States, as well as in related internet and television advertising. *Id.* ¶8 & Ex. C.

10. From approximately 2001 to 2005, the VIAGRA® brand also was an official sponsor at National Association for Stock Car Auto Racing (NASCAR) events, which included sponsorship of VIAGRA®-branded racecars on the national NASCAR racing circuit as well other VIAGRA® advertising at NASCAR events. *Id.* & Ex. C.

11. Pfizer routinely sponsored a Men’s Mobile Health Unit at NASCAR racing events, where men were provided with health information as well as free medical screening for medical issues such as high blood pressure, high cholesterol, elevated blood sugar levels, and erectile dysfunction. *Id.* ¶18 & Ex. F.

12. Because of these sponsorships, millions of American consumers have seen VIAGRA® advertising at Major League Baseball and NASCAR events and during television coverage of those events. *Id.* ¶8.

13. In July 2007, Pfizer launched a major new national advertising campaign for its VIAGRA® product, the centerpiece of which is the slogan VIVA VIAGRA. *Id.* ¶13.

14. Virtually all of Pfizer's advertisements since mid-2007 have prominently featured the slogan VIVA VIAGRA, and many include a song that features the words VIVA VIAGRA. These advertisements have appeared extensively on television and radio, in print and on the Internet. *Id.* ¶15 & Ex. D.

15. Since the launch of the VIVA VIAGRA advertising campaign, over 150 million American consumers have seen Pfizer's television, print, radio, and online VIVA VIAGRA advertisements featuring the Viagra Marks. *Id.* ¶16.

16. The VIVA VIAGRA campaign has been well received. In numerous unsolicited news stories in early 2008 concerning the tenth anniversary of the launch of the VIAGRA® product, reporters referred to the VIVA VIAGRA slogan and even sung the VIVA VIAGRA song in news reports. *Id.* ¶17.

17. Pfizer also has used both the VIAGRA® mark and VIVA VIAGRA mark widely in connection with various education initiatives related to the VIAGRA® product and erectile dysfunction, including, in particular, medical information services directed to men's sexual health issues. *Id.* ¶18 & Ex. E.

18. The VIVA VIAGRA slogan is routinely depicted in Pfizer's advertisements in blue text, with the word "VIAGRA" in block type preceded by the word "VIVA" written at an angle in cursive type. *Id.* ¶15 & Ex. D.

19. Pfizer owns a pending U.S. trademark application to register the VIVA VIAGRA mark, Serial No. 77/043,506, to register the mark VIVA VIAGRA for “Printed materials, namely booklets, pamphlets and posters on the topic of men’s sexual health” and “Medical information services, namely, providing information relating to men’s sexual health; on-line information services, namely providing information relating to men’s sexual health via a global computer network.” Trunko Decl. ¶4 & Ex. B.

20. Pfizer’s extensive marketing, advertising and promotion of its VIAGRA® product under the Viagra Marks has been highly successful, as demonstrated by the response of consumers. In the United States alone, the VIAGRA® product has achieved billions of dollars of sales since it was launched in 1998, and worldwide sales have reached over sixteen billion dollars. Dovdavany Decl. ¶9.

21. The VIAGRA® product has been used by approximately 35 million men worldwide, including approximately 19 million men in the United States. *Id.*

22. Defendants concede that the VIAGRA® mark is known to every “man, woman [and] child over the age of sixteen in this country.” See Def. Opp. Br. at 2 & App’x 2 [Dkt. #7].

23. By virtue of Pfizer’s substantial use, sales, advertising, and promotion of the Viagra Marks throughout the United States and abroad, the enormous publicity and media attention accorded to the marks, and the inherently distinctive nature of the marks, the Viagra Marks have become well-known and famous marks, have become distinctive of Pfizer’s products and services, and have come to serve to identify and indicate the source of Pfizer’s products and services to consumers, purchasers and others. Dovdavany Decl. ¶11.

24. The Viagra Marks have come to identify and indicate the source of Pfizer's products and services to consumers, purchasers and others, and have developed substantial goodwill and an excellent reputation among consumers. As a result, the Viagra Marks are among Pfizer's most valuable corporate assets. *Id.*

25. Pfizer has acted with diligence in policing the use and misuse by other parties of trademarks similar or identical to its famous VIAGRA® mark when such uses have come to Pfizer's attention. Trunko Decl. ¶¶11-16.

26. In the years since the launch of its VIAGRA® product, Pfizer has sent hundreds of cease-and-desist letters to companies and persons that have attempted to use marks confusingly similar to the VIAGRA® mark or that have unlawfully misappropriated the VIAGRA® mark to promote their goods and services, resulting in numerous voluntary agreements to cease infringing the VIAGRA® mark or, in many cases, the voluntary cessation of infringing activities. *Id.* ¶11.

27. Pfizer has commenced at least 29 lawsuits in the United States against entities that have infringed, diluted, or otherwise misused Pfizer's VIAGRA® trademark. A number of these lawsuits have resulted in consent judgments acknowledging Pfizer's exclusive rights in the VIAGRA® mark and enjoining further infringement and dilution of the mark. *Id.* ¶12.

28. At least two federal courts have held on the merits that Pfizer has strong rights in the VIAGRA® mark, and have enjoined defendants from infringing the mark. In *Pfizer, Inc. v. CitroBio, Inc.*, No. 8:02-cv-516-T-23TGW (M.D. Fla. July 8, 2002), the Court granted a preliminary injunction against defendants' use of the mark FEMAGRA, holding that the VIAGRA® mark is "very strong" and noting that Pfizer has engaged in

“aggressive policing” of the mark. And, in *Pfizer, Inc. v. Y2K Shipping & Trading, Inc.*, 2004 WL 896952 (E.D.N.Y. Mar. 26, 2004), the Court granted summary judgment to Pfizer on its claim that TRIAGRA infringed the VIAGRA® mark, holding that the mark “is strong and is therefore entitled to the greatest degree of protection under the Lanham Act.” *Id.* ¶13 & Exs. J,K.

29. Pfizer also has commenced over thirty trademark opposition proceedings before the U.S. Patent & Trademark Office (“PTO”) concerning marks that infringe or dilute the VIAGRA® trademark. Nearly all of these proceedings already have been resolved in Pfizer’s favor. *Id.* ¶14.

30. Pfizer also has commenced over sixty “cyberquatting” Internet domain name disputes before the World Intellectual Property Organization (WIPO) concerning domain names that infringe and dilute the VIAGRA® mark, and has obtained favorable decisions or outcomes in all of these, resulting in a transfer of the domain name to Pfizer or de-registration. *Id.* ¶15.

31. Pfizer has an extensive and active anti-counterfeiting program for VIAGRA® tablets and other Pfizer products. Pfizer regularly cooperates with law enforcement agencies and customs offices to identify and prosecute counterfeiters of VIAGRA® tablets and other Pfizer products. Since 2004, law enforcement and government agencies, working in cooperation with Pfizer, have seized over 2 million counterfeit VIAGRA tablets in the United States and over 23 million counterfeit VIAGRA tablets worldwide. *Id.* ¶16.

Defendants’ Misappropriation and Unauthorized Use of the Viagra Marks

32. Defendants are engaged in the business of selling mobile outdoor advertising on actual and replica military equipment, such as fighter jets and missiles, which defendants

display in metropolitan areas including in the State of New York. Dovdavany Decl. ¶21 & Ex. G.

33. Defendants describe and promote their advertising services on a website at <http://jetangel.com>. *Id.* & Ex. G.

34. Defendants' website states that JetAngel offers "an innovative, community-friendly alternative to conventional mobile branding, wrap-up ads and old, controversial billboards," describes various outdoor advertising programs offered by Jet Angel and describes at length the claimed benefits that a company can enjoy by using defendants' advertising services. *Id.* ¶22 & Ex. G.

35. Under the heading, "WHAT WE DO," defendants' website states: "In an era where advertisers are competing for customer attention, Jet Angel is introducing extreme out-of-home advertising and promotional platforms that cannot be duplicated by competitors." *Id.* ¶21 & Ex. G.

36. Defendants' website also features illustrations of military equipment bearing the VIAGRA® mark, which was not authorized by Pfizer, as well as other well-known trademarks such as COCA-COLA®, CNN®, BUDWEISER®, and BAYER®. *Id.* ¶24 & Ex. G.

37. Defendants' website specifically identifies defendants' military missiles as a platform for the advertising services offered by defendant. The website contains illustrations of how defendants offer to carry advertisers' brand names on missiles, and states that these missiles are a "cool-looking, attention-grabbing advertising platform." *Id.* ¶23 & Ex. G.

38. Defendants used the Viagra Marks by displaying them without Pfizer's authorization on missiles that defendants have driven through New York City and other locations, using pickup trucks that also feature prominent advertising for defendants' business and services. *Id.* ¶¶26-27 & Exs. H, I; Trunko Ex. G.

39. In particular, on September 8, 2008, defendants displayed in Manhattan, and even brought to Pfizer's world headquarters on 42nd Street, a missile prominently bearing Pfizer's VIVA VIAGRA mark and logo on its side in the same color and distinctive lettering style used in Pfizer's own VIVA VIAGRA advertisements. Dovdavany Decl. ¶¶25-27 & Exs. H, I.

40. Defendants concede that the missile had the "logo of VIAGRA" "painted on it." Def. Opp. Br. App'x 2 at 1 [Dkt. #7]

41. The VIAGRA-branded missile was approximately 15-20 feet in length and 2-3 feet in diameter. Dovdavany Decl. ¶26.

42. Upon meeting Pfizer personnel on September 8, 2008, defendant Sachs identified himself as being affiliated with a company called Jet Angel or JetAngel.com. *Id.*

43. Before departing from Pfizer on September 8, defendant Sachs left a promotional pamphlet about himself and his business with Pfizer. After leaving the parking space, Mr. Sachs made two or more additional passes in front of Pfizer's office. *Id.* ¶27 & Ex. J.

44. The next day, September 9, 2008, defendants sent an email to Pfizer in which they indicated that they planned to return with a VIAGRA-branded missile, along with "two models handing out free condoms." That email stated:

<http://jetjewel.com/JET/VIA.html> - CHECK IT OUT IMMEDIATELY!!!!

Jet Angel hopes that you enjoyed yesterday's visit to NYC including all your free PR. It is the intention to make a second trip next week, with the VIAGRA Missile, and "riding" on top will be two models handing out free condoms!

LOOK AT ALL THE PEOPLE STARRING [*sic*], THE JOY, THE IMPRESSIONS!!!!

Id. ¶28 & Ex. K.

45. The web page referenced in the September 9 email, <http://jetjewel.com/JET/VIA.html>, contained a number of additional photographs of defendants' VIAGRA-branded missiles in various locations around Manhattan, including at Trump Tower, at the Grace building on 42nd Street, in Times Square, and at Pfizer's 42nd Street world headquarters. *Id.* ¶29 & Ex. L.

46. On September 9, 2008, counsel for Pfizer sent a letter to defendants notifying them, among other things, that their use of Pfizer's Viagra Marks was not authorized, and demanding that they agree no later than September 10, 2008 to cease all use of the Viagra Marks. *Id.* ¶30; Trunko Decl. ¶6 & Ex. C.

47. On September 11, 2008, having received no response from defendants, counsel for Pfizer sent them a second letter in which Pfizer again demanded that defendants cease all use of Pfizer's trademarks, and reserved its rights to pursue legal remedies with respect to defendants' conduct. Dovdavany Decl. ¶31; Trunko Decl. ¶6 & Ex. D.

48. On the morning of Friday, September 12, 2008, defendants sent a brief email to counsel for Pfizer that stated:

Dear Mr. Llewellyn.

You will receive my personal respectful response by email no later than tonight.

Sincerely
Arye Sachs

Dovdavany Decl. ¶32; Trunko Decl. ¶7 & Ex. E.

49. Defendants sent no further response on September 12, 2008. Instead, that weekend, defendants exhibited a VIAGRA-branded missile (and a prominent sign advertising their own business) at “EXXXOTICA New York,” an adult entertainment exposition in New Jersey, as well as at other locations in New York. Trunko Decl. ¶¶8-9 & Exs. G, H; Dovdavany Decl. ¶34.

50. There is no evidence that prior to taking any of the foregoing actions defendants sought the advice of counsel.

51. On September 14, 2008, at 11:05 pm, defendants sent an email response to Pfizer’s September 9 and 11 letters, stating, *inter alia*, that they intended to continue to display their several VIAGRA-branded missiles, including on a “tour” of “New York and twelve other major cities across the United States” in which free condoms bearing depictions of presidential candidates Barack Obama and John McCain would be distributed by defendants to the public. The September 14 response further stated:

“In spite of your threats, our national tour will continue as planned.

(Today’s updates: <http://jetangel.com/VIAGRASEPT152008.HTML>)”

The web page referenced included additional photographs of the VIAGRA-branded missile(s). Trunko Decl. ¶8 & Ex. F; Dovdavany Decl. ¶33.

52. With respect to their threatened “tour” with their VIAGRA-branded missiles, defendants wrote, “You may wish to follow its progress in the press. In the meantime please, *Allez vous faire foutre avec votre Viagra*,” which roughly translates to English as “Go get f***ked with your Viagra.” *Id.*

53. Defendants “stand[] behind...[this] statement...100 percent, and if not for respect to the court...would have reaffirmed it in vivid colors.” Def. Am. Opp. Br. at 21 [Dkt. #12].

54. On September 17, 2008 defendants distributed a press release announcing it had embarked on a nationwide campaign in Washington, D.C., New York City, and other major cities, with “Candidates’ Names on Viagra Missiles,” the exhibition at various landmarks of missiles that “carry the ‘Viva Viagra’ logo with [the] slogan, ‘Practice Safe Politics,’” and the intent to distribute condoms with images of Barack Obama and John McCain as defendants exhibit their VIAGRA-branded missiles. The press release ends with the statement “Advertising with Jet Angel is available through AVI Media Group,” followed by a telephone number and the www.jetangel.com Internet address. Trunko Decl. ¶10 & Ex. I.

Harm to Pfizer Caused by Defendants Misappropriation of Pfizer’s Viagra Marks

55. Defendants have never been authorized by Pfizer to use the Viagra Marks in connection with their business, services, or products. Dovdavany Decl. ¶25.

56. Pfizer has no control over the nature and quality of the services and products provided by defendants. *Id.* ¶35.

57. Because of the wholesale misappropriation and threatened misappropriation of the Viagra Marks by defendants, many actual and potential purchasers and consumers who are confused as to the origin, source or sponsorship of defendants VIAGRA-branded missiles are likely to mistakenly believe that the missiles are a Pfizer-authorized element of Pfizer’s VIVA VIAGRA national advertising campaign. *Id.*

58. People who mistakenly believe that Pfizer is advertising its VIAGRA® product using models distributing condoms to the public and at adult entertainment events, or

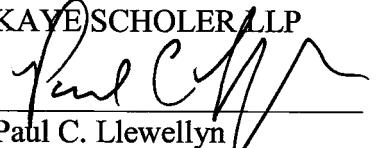
who mistakenly believe that Pfizer is somehow affiliated or associated with such advertising activities, may well be offended at the idea of advertising an erectile dysfunction medicine in this manner. *Id.*

59. Defendants' use of the Viagra Marks on military missiles, in connection with the distribution of condoms by models, and at adult entertainment conventions harms the reputation of those marks. This is because such uses trivialize the fact that VIAGRA® treats a serious medical condition and, particularly in the case of adult entertainment conventions, associates the Viagra Marks with pornography and other potentially offensive materials. *Id.* ¶38.

60. Defendants concede that people will view advertising on missiles "negative[ly]" and as "too aggressive." Def. Am. Opp. Br. at 22 [Dkt. #12].

61. Such injury to the Viagra Marks will reduce the value of the marks. Dovdavany Decl. ¶38.

Dated: New York, New York
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